

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Honeywell Docket No. H0004181-5601
 (MBHB No. 07-165)

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In re the Application of:)
) Group Art Unit: 2834
 Horning)
) Examiner: Karl I. Tamai
 Serial No.: 10/673,453)
) Confirmation No.: 2002
 Filed: September 30, 2003)
) FAX NO. (571) 273-8300
 For: Polymer Actuator Having)
 A Circular Unit Cell) TOTAL PAGES: 4

Mail Stop Appeal Brief - Patents
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

FACSIMILE TRANSMITTAL LETTER

In regard to the above identified application:

1. We are transmitting herewith the attached

Reply Brief

2. With respect to additional fees:

- A. No additional fee is required.
- B. Attached is a check in the amount of \$0.00.
- C. Charge the total fee due or credit any overpayment to our Deposit Account No. 13-2490. A duplicate copy of this sheet is enclosed.

3. CERTIFICATE UNDER 37 CFR 1.8(a). The undersigned hereby certifies that this Transmittal Letter and the paper, as described in paragraph 1 hereinabove, are being transmitted to the USPTO facsimile number 571-273-8300, according to 37 CFR 1.6(d) addressed to: Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, ATTN: Karl I. Tamai.

Respectfully Submitted,
 McDonnell Boehnen Hulbert & Berghoff LLP

By _____

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Date: April 9, 2007

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**Honeywell Docket No. H0004181-5601
(MBHB No. 07-165)**

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REPLY BRIEF

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I. Introduction

This Reply Brief addresses the specific arguments made in the Examiner's Answer (mailed February 9, 2007) to Applicant's Appcal Brief. Applicant respectfully submits that the Examiner's Answer does not sufficiently rebut Applicant's arguments explaining why the present rejections are improper.

II. Argument

The Examiner erred in rejecting independent claims 1, 7, and 12 under 35 U.S.C. § 103(a) as being obvious over a combination of U.S. Patent Application Publication No. 2002/0125790 (Horning) and U.S. Patent No. 5,180,623 (Ohnstein), because the Examiner failed to provide a sufficient motivation to combine Horning and Ohnstein.

As noted in Section VII(A) of Applicant's Appeal Brief, Horning fails to disclose a circularly-shaped cell. In the Examiner's Answer, in attempting to offer a motivation to combine the circular-shaped closure plate of Ohnstein to the cell shape of Horning, the Examiner argued that "Ohnstein clearly teaches that the inclusion of a hole in circular flexible electrostatic sheets (see figure 6a) allows the device to be operated as a semiconductor electrostatic valve." Examiner's Answer, pg. 5, line 20-21. Although Ohnstein discloses use of a circular closure plate, Ohnstein does not state that it is the circular shape of the closure plate that specifically allows the device of Ohnstein to operate as a semiconductor electrostatic valve. Rather, Ohnstein discloses that a closure plate with a circular shape operates similarly to that of a closure plate with another shape. *See, e.g.*, Ohnstein, col. 6, lines 5-8. Further, Ohnstein offers no explanation as to why a closure plate with a circular shape offers advantages over or operates differently from a closure plate with a different shape.

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Since Ohnstein offers no explanation as to why a circular-closure-plate shape offers advantages over or operates differently from any other closure-plate shape, and since the Examiner has not pointed to any other objective evidence in either Horning or Ohnstein to combine the references, the Examiner has failed to provide a sufficient motivation to combine Horning and Ohnstein. Given that the Examiner has not provided a sufficient motivation to combine Horning and Ohnstein, the Examiner has failed to establish a *prima facie* case of obviousness of these claims. Accordingly, Applicant respectfully submits that the Examiner's rejection of independent claims 1, 7, and 12 is improper, and should be reversed. Further, claims 2-6, 8-11, 13-15, and 22-26, which depend from and include all of the limitations of at least one of independent claims 1, 7, and 12, are allowable for at least the reason they each depend from an allowable claim base.

III. Conclusion

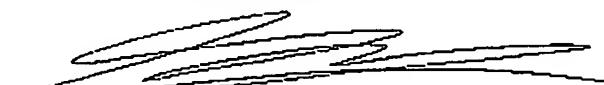
Applicant has demonstrated that the rejection of claims 1-15 and 22-26 are in error as a matter of law. Applicant therefore requests reversal of the rejections and allowance of all pending claims in this application.

Respectfully submitted,

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Date: April 9, 2007

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